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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/707,430	11/06/2000	Paul J. Cornay	5770.04	1466

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EXAMINER

COOLEY, CHARLES E

ART UNIT PAPER NUMBER

1723

DATE MAILED: 03/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/707,430

Applicant(s)

Cornay

Examiner

Charles Cooley

Art Unit

1723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 Mar 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-6 and 13-15 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-6 and 13-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☒ The proposed drawing correction filed on 29 May 2000 is: a) ☒ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

Art Unit: 1723

OFFICE ACTION

Drawings

1. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 29 MAY 2001 have been approved by the Examiner.

Specification

2. The abstract is acceptable.
3. The title is acceptable.

Claim Objections

4. Claim objected to because of the following informalities:
 - a. Claim 3 was not amended properly in accordance with 37 CFR 1.121 with respect to the previous version of claim 3 appearing in the amendment filed 03 OCT 2001 which Applicant requested entry of in the Request for RCE filed 31 OCT 2001. Note in line 6 of claim 3 filed 15 MAR 2002, the words "including tubes, said tubes defining walls" were stricken yet the marked-up copy gives no indication the words were deleted. In line 8, the word "concentric" was added yet the marked-up copy gives no indication the word was added.

Appropriate correction is required.

Art Unit: 1723

Claim Rejections - 35 U.S.C. § 112

5. Claims 3-6 and 13-15 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3, line 8: "said concentric tube walls" lacks antecedent basis.

Claim 13, line 2: the "innermost" designation is with respect to what reference axis, surface, or plane? Is the innermost tube the tube which extends the shortest distance in the radial direction or is it the tube which is the smallest diameter tube (i.e., the concentrically innermost tube) in the separation chamber? The confusion surrounding the recitation of "an innermost tube" thus renders the scope of the claim indefinite.

Claim 14, line 2: "said heavier materials" lacks antecedent basis.

Claim Rejections - 35 U.S.C. § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

Art Unit: 1723

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 3-5, 13, and 14 are rejected under 35 U.S.C. § 102(b) as being anticipated by Nerad.

The patent to Nerad discloses a centrifuge comprising a housing 7 having a central body (above 13) with a top and bottom collar (the areas above and below 27); the central body defining an axis; a hollow arm 23 extending from the central body with a first end attached to the central body and a second end extending away from the central body (Figs. 1-2); the hollow arm 23 defining a chamber therein; a baffle 22 attached to the central body and extending into the chamber of the hollow arm 23; the baffle 22 defining flow paths between concentric tube walls (one path being within the baffle 22 and another being between the outer portion of the baffle 22 and the inner portion of the arm 23); a frame 12, 17 supporting the housing 10 for rotation of the arm; and a bearing 14 engaging the top collar (above 27); and an innermost tube 13.

With regard to the above rejection, the operational and functional language of claim 14 has been considered but is deemed but a method of operation of an apparatus which fails to impart or invoke any means or structure to the *apparatus* claims which defines over the applied prior art.

Art Unit: 1723

Claim Rejections - 35 U.S.C. § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 6 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Nerad in view of Coleman.

Nerad discloses a drive motor 16 for providing rotational motion but does not disclose the recited ring gear. Coleman discloses a drive means for a centrifuge comprising a drive motor 29 and a ring gear 26 coupled to housing 14 and the motor 29. In view of the teachings of Nerad which suggests that any suitable means for rotating the centrifuge may be employed (Col. 2, lines 16-19), it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have provided the centrifuge of Nerad with a motor and ring gear drive means as disclosed by Coleman for the purpose of providing a simple and efficient means for imparting motion to the centrifuge (Col. 1, lines 18-20).

Art Unit: 1723

Allowable Subject Matter

10. Claim 15 would be allowable if rewritten to overcome the rejection under 35 U.S.C. § 112 and to include all of the limitations of the base claim and any intervening claims.

Response to Amendment

11. Applicant's arguments filed 15 MAR 2002 have been fully considered but they are not deemed to be persuasive.

Turning to the rejection of the claims under 35 U.S.C. § 102(b), it is noted that the terminology in a pending application's claims is to be given its broadest reasonable interpretation (*In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)) and limitations from a pending application's specification will not be read into the claims (*Sjolund v. Musland*, 847 F.2d 1573, 1581-82, 6 USPQ2d 2020, 2027 (Fed. Cir. 1988)). Anticipation under 35 U.S.C. § 102(b) is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of a claimed invention. See *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1570, 7 USPQ2d 1057, 1064 (Fed. Cir.), cert. denied, 488 U.S. 892 (1988); *RCA Corp. v. Applied Digital Data Sys., Inc.*, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). Moreover, anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or the recognition of

Art Unit: 1723

properties that are inherently possessed by the prior art reference. *Verdegaal Brothers Inc. v. Union Oil co. of California*, 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 827 (1987). A prior art reference anticipates the subject matter of a claim when that reference discloses each and every element set forth in the claim (*In re Paulsen*, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994) and *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990)); however, the law of anticipation does not require that the reference teach what Applicant is claiming, but only that the claims "read on" something disclosed in the reference. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), *cert. denied*, 465 U.S. 1026 (1984) (and overruled in part on another issue), *SRI Intel v. Matsushita Elec. Corp. Of Am.*, 775 F.2d 1107, 1118, 227 USPQ 577, 583 (Fed. Cir. 1985). Also, a reference anticipates a claim if it discloses the claimed invention such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention. See *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995), *cert. denied*, 116 S.Ct. 1362 (1996), quoting from *In re LeGrice*, 301 F.2d 929, 936, 133 USPQ 365, 372 (CCPA 1962).

With respect to the applied prior art under 35 U.S.C. § 102(b), the examiner has demonstrated how the Nerad reference discloses each and every element set forth in

Art Unit: 1723

the claims and how the pending claims read on the disclosure of the reference, hence the rejection is considered proper.

Applicant argues that the patent to Nerad does not disclose an exit path for guiding heavier materials out of the housing. However, Nerad does disclose multiple flow paths between concentric tube walls as noted above which meets the recitation of the first and second paths in claim 3. The "for guiding" the materials out of the housing functions are not deemed to invoke 35 USC 112, sixth paragraph and claim 3 recites nothing as to the geometry of the paths or further structure that forms the paths that would define over Nerad. All that is recited is multiple paths which is met by Nerad. The function of the paths does not further limit the paths (as 112, sixth paragraph is not invoked) and is merely tantamount to an intended use of the paths.

Such an intended use has not been afforded any patentable weight because it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647; *In re Sebald*, 122 USPQ 527; *In re Lemin et al.*, 140 USPQ 273; *In re Sinex*, 135 USPQ 302; *In re Pearson*, 181 USPQ 641.

Further, it is noted that claim 3 is much broader in scope (by amendment and by improper revision under 37 CFR 1.121) than the previous version of claim 3 considered before this final office action.

Art Unit: 1723

Note, however, that claim 15 presents a structural limitation in means plus function format which is neither taught or suggested by Nerad and is thus considered allowable.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION. **ANY RESPONSE FILED AFTER THE MAILING DATE OF THIS FINAL REJECTION WILL BE SUBJECT TO THE PROVISIONS OF MPEP 714.12 AND 714.13.**

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Charles Cooley whose telephone number is ☎ (703) 308-0112.

Art Unit: 1723

14. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1700 receptionist whose telephone number is ☎ (703) 308-0651.

Dated: **26 March 2002**

A handwritten signature in black ink, appearing to read "Charles Cooley", written over a horizontal line.

Charles Cooley
Primary Examiner
Art Unit 1723